

**REMARKS**

Claims 1-14, 16-45 and 47-63 are pending in this application. Claims 1 and 30 are independent claims.

By this amendment, claim 1, 16, 17, 30, 47, 48 and 63 are amended and claims 15 and 46 are canceled without prejudice or disclaimer thereto.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

**The September 21, 2006 Office Action Supercedes**

Applicant respectfully clarifies for the record that the September 21, 2006 Office Action supercedes both the May 26, 2006 Office Action and the August 10, 2006 Office Action.

As such, applicant was not required to response to either the May 26, 2006 Office Action and/or the August 10, 2006 Office Action, due to minor defects found therein.

**Personal Interview**

Applicant wishes to thank both Examiner Aggarwal and supervisor Srivastava for the courtesies extended to Applicant's representative, Carolyn Baumgardner, during the various telephonic interviews made prior to the issuance of the September 21, 2006 Office Action. During the interviews, the minor defects of the previous Office Actions were discussed, resulting in a new non-final Office Action being issued.

**The Claims Define Patentable Subject Matter**

The Office Action makes the following rejections:

(1) claims 1, 3, 4 and 14 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,977,680 to Ichihara (hereafter *Ichihara*);

(2) claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of U.S. Patent No. 6,297,890 to Nanba (hereafter *Nanba*);

(3) claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of the Tamura patent (JP 09-37125);

(4) claims 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of *Tamura* and further in view of the Tomat patent (US 6,784,925);

(5) claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of the Allen patent (US 5,737,491);

(6) claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of the Oie patent (US 6,188,431);

(7) claims 15-21 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of the Niikawa publication (2002/0101440);

(8) claims 22-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of *Niikawa* and *Tomat*;

(9) claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of *Niikawa* and *Allen*;

(10) claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of *Niikawa* and *Oie*;

(11) claim 63 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Ichihara* in view of the Shiohara patent (US 6,618,553) (hereafter *Shiohara*);

(12) claims 30-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No.6,263,106 to Yamagata (hereafter *Yamagata*) in view of *Nanba*;

(13) claims 34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of the *Tamura*;

(14) claims 35-37 and 39-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and *Tamura* and further in view of *Tomat*;

(15) claim 44 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of *Allen*;

(16) claim 45 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and *Oie*;

(17) claims 46-51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of *Niikawa*;

(18) claims 52-54 and 56-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Tomat*;

(19) claim 61 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Allen*; and

(20) claim 62 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Oie*.

All of the above-noted rejections are respectfully traversed.

In the non-final Office Action, although a plurality of references are being applied in rejecting claims 1-63, it appears that the Examiner is mainly relying upon the *Ichihara* patent with regards to claims 1-29 and 63, either alone or in combination with various other references; and is mainly relying on the combination of *Yamagata and Nanba* with regards to claims 30-62, either alone or in combination with various other references.

As such, applicant's comments will mainly be directed to the deficiencies of *Ichihara, Yamagata and Nanba*; and a select few other secondary references.

*Ichihara* fails to Anticipate the Claimed Invention  
as set forth in Claim 1

Firstly, applicant respectfully submits that the claimed invention as set forth in independent claim 1 is distinguishable from *Ichihara* for at least the following reasons:

For example, in the present invention a camera 10 can capture the main image data, produce reduced image data based thereon, and store an image file containing both the main image data and the reduced image data in a storage medium. A communication device transmits the image file stored in the storage medium to an external apparatus. An information processing device deletes from the image file the main image data after the communication device transmits the image file and keeps the reduced image data of the image file after the main image data is deleted.

As conceded by the Examiner, *Ichihara* fails to disclose a processing device that generates thumbnail data in a digital camera and a control device that controls such a processing device. (see Office Action, page 10 regarding rejection to claim 63). As such, *Ichihara* fails to teach or suggest transmitting an image file that includes both the subject main image data and the reduced image data to an external apparatus, as set forth in claim 1.

However, in an attempt to show such a feature, the Examiner imports *Shiohara*. (see rejection of claim 63). Specifically, the Examiner alleges that *Shiohara* discloses a digital camera 100 that has a processing device 7 that generates a thumbnail image and a control section 4 for controlling the operation of the signal processing section 7. (see Office Action, page 10).

However, applicant respectfully submits that even if *Shiohara* discloses a processing device in a digital camera that produces thumbnail images, both *Shiohara* and *Ichihara* fail to teach or suggest transmitting an image file that includes both the subject main image data and the reduced image data to an external apparatus.

*Ichihara* fails to even disclose a camera capable of producing thumbnail images and *Shiohara* fails to disclose recording the thumbnail image in an image file along with the subject main image data and transmitting said image file to the external apparatus. *Shiohara* merely discloses that the signal processing section 7 prepares a thumbnail image and a recording medium control section 8 controls writing the image data compressed in JPEG and the thumbnail image data into predetermined locations of a recording medium 9 or 10. (see

*Shiohara*, col. 4, lines 1-33). However, *Shiohara* fails to disclose that both the main image data and the thumbnail image data are stored in an image file that is transmitted to the external apparatus. Instead, *Shiohara* merely discloses that the selected thumbnail image data is outputted to an external system. (see *Shiohara*, col. 3, lines 1-23).

Furthermore, *Shiohara*, fails to teach or suggest that the subject main image data is deleted after the image file is transmitted and that the reduced image data is kept.

Furthermore, the Examiner alleges that *Niikawa* discloses the generation of thumbnail image data and main image data in a single file, which must be generated or deleted simultaneously in order to conform to the EXIF standard. (see Office Action, pages 8-9). However, applicant submits that even if *Niikawa* discloses a single file for thumbnail image data and main image data, *Niikawa* fails to disclose that such a single file is transmitted to an external apparatus and that the main image data is subsequently deleted from the single file after transmission of the image file.

For at least the reasons noted above, applicant respectfully submits that *Ichihara*, either alone or in combination with *Shiohara* and/or *Niikawa*, fails to teach or suggest an information processing device that creates a reduced image data and stores an image file including both the subject main image data and the reduced image data and transmits the image file to an external apparatus. In other words, none of *Ichihara*, *Shiohara* or *Niikawa* discloses transmitting such an

image file to an external apparatus and deleting the main image data therefrom after the transmission.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 ( Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, *Ichihara*, either alone or in combination with the other cited references, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1 is allowable over *Ichihara* for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 3, 4 and 14 under 35 U.S.C. §102(e) is respectfully solicited.

### §103 Rejections

Applicant respectfully submits that each of *Nanba*, *Tamura*, *Tomat*, *Allen*, *Oie*, *Niikawa*, and *Shoihara* fail to make up for the deficiencies found in *Ichihara*. As such, applicant respectfully submits that *Ichihara*, either alone or in combination with the other cited art, fails to make the claimed invention obvious, for at least the reasons noted above.

Furthermore, applicant respectfully submits that the combination of *Yamagata* and *Nanba* fails to teach or suggest the claimed invention as set forth in independent claim 30.

For example, the Examiner concedes that *Yamagata* fails to teach transmitting image data to an external device. (see Office Action, page 12). In an attempt to show this feature, the Examiner imports *Nanba*. However, applicant respectfully submits that *Nanba* fails to make up for the deficiencies of *Yamagata*.

For example, in contrast with the present invention, both *Yamagata* and *Nanba* (or any combination thereof, assuming these teachings may be combined, which applicant does not admit) fail to teach or suggest transmitting an image file stored in a storage medium to an external apparatus, whereby the image file includes both main image data and reduced image data.

For instance, both *Yamagata* and *Nanba* fail to teach or suggest transmitting stored image data (i.e., an image file) to an external apparatus.

In other words, in *Yamagata* the image data is merely transferred between memories in the digital camera itself, but



is never transferred externally. The Examiner even concedes that Yamagata fails to disclose transmitting the data externally. (see Office Action, page 12).

Also, Nanba fails to disclose transmitting stored image data to an external device. Furthermore, Nanba fails to disclose that the image file transmitted externally includes both main image data and reduced image data.

For example, while Nanba does transmit data to an external PC, Nanba fails to transmit data that has been stored in a storage medium, as set forth in claim 30. Instead, Nanba looks at situations where the memory card is not installed in the camera or the remaining capacity of the memory card is not sufficient, and under such circumstances the photographed image is automatically recorded in the hard disk of the PC. (see Nanba, col. 8, lines 14-18). In other words, Nanba merely chooses between a first and second recording medium, i.e., either in the camera itself or in the external PC, but not both.

As such, the data that is transmitted to the PC (external device) in Nanba is never stored in any medium in the digital camera. As a result, both Yamagata and Nanba fail to disclose transmitting image data that is stored in a storage medium to an external device.

Furthermore, Nanba fails to disclose that the image data transmitted externally is an image file that includes both main image data and reduced image data. Instead, Nanba merely discloses that only main image data is transmitted to the PC 1000. (see Nanba, col. 8, lines 4-5). As such, both Yamagata and Nanba fail to teach or suggest transmitting an image file as claimed externally.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that not only does the combination of *Yamagata* and *Nanba* fails to teach or suggest each and every feature as set forth in independent claim 30 as noted above, but the Examiner has also failed to provide proper motivation for combining *Yamagata* with *Nanba*.

Applicant respectfully submits that but for applicant's own disclosure of the specific features involved, i.e., the data form, and the storage thereof after specific steps, the applied references themselves would not have instructed one versed in the art on how to go about selectively reworking and modifying *Yamagata's* device/process to yield applicant's claimed invention.

Accordingly, applicant submits that the Examiner's 103(a) rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

In addition, applicant submits that the Office Action has improperly used applicant's invention as a road map to pick and choose features and paste the chosen features together to arrive at the claimed invention, even though the cited references do not provide any teachings, suggestion or motivation to make the modification.

Applicant respectfully submits that the combination of Yamagata and Nanba fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 30 is allowable over the combination of Yamagata and Nanba for at least the reasons noted above.

Furthermore, applicant respectfully submits that Tamura, Tomat, Allen, Oie, and Niikawa all fail to make up for the deficiencies found in the combination of Yamagata and Nanba noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 2, 5-13 and 15-63 under 35 U.S.C. §103(a) is respectfully requested.

### Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for

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allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

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